



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,783	02/13/2002	Kevin Carl Archibald	15-EC-6102	9498
23465	7590	08/29/2006	EXAMINER	
JOHN S. BEULICK C/O ARMSTRONG TEASDALE, LLP ONE METROPOLITAN SQUARE SUITE 2600 ST LOUIS, MO 63102-2740			PASS, NATALIE	
		ART UNIT		PAPER NUMBER
		3626		
DATE MAILED: 08/29/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/683,783	ARCHIBALD ET AL.	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 May 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 17 May 2006. Claims 1-24 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 9-10, and 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Malley et al, U.S. Patent Application Publication Number 2002/0026408 for substantially the same reasons given in the previous Office Action (paper number 04172006). Further reasons appear hereinbelow.

(A) Claims 1-2, 9-10, and 17-18 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 04172006, section 3, pages 2-4), and incorporated herein.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Malley et al, U.S. Patent Application Publication Number 2002/0026408 as applied to claims 1, 9, and 17 above, and further in view of Singh, U.S. Patent Application Publication Number 2001/0047311 for substantially the same reasons given in the previous Office Action (paper number 04172006). Further reasons appear hereinbelow.

(A) Claims 3, 11 and 19 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 04172006, section 5, pages 4-6), and incorporated herein.

5. Claims 4-8, 12-16, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Malley et al, U.S. Patent Application Publication Number 2002/0026408 as applied to claims 1, 9, and 17 above, and further in view of Duke, International Publication Number WO 01/37177 A1 for substantially the same reasons given in the previous Office Action (paper number 04172006). Further reasons appear hereinbelow.

(A) Claims 4-8, 12-16, and 20-24 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 04172006, section 6, pages 6-11), and incorporated herein.

Response to Arguments

3. Applicant's arguments filed 17 May 2006. have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 17 May 2006.

(A) At pages 2-16 of the 17 May 2006 response, Applicant argues that the claim limitations in the 31 May 2000 Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of the cited references, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 102 and 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 04172006), and incorporated herein. In particular, Examiner notes that the limitations of a network based method for facilitating providing a customer with a quote for at least one of a manufactured product and a service that includes providing the customer a budgetary quote based on the received data receiving a customer

response based on the budgetary quote and providing the customer a contractual quote based on the received customer response are taught by the cited reference (O'Malley; Figure 3, paragraph [0028], [0032]); Examiner interprets O'Malley's teachings of "RFQ providers 105 may use the data to provide one or more quotes to user" (O'Malley; Figure 3, paragraph [0028]) and "browser 403 may receive one or more quotes from RFQ providers" (O'Malley; Figure 4, paragraph [0032]) as teaching the argued limitations. Furthermore, Examiner interprets O'Malley's teachings of "[u]pon receiving the quote from any of RFQ providers ... [...] ... user 109 may send an electronic mail message to RFQ providers 105 and/or RFQE system 111 signifying acceptance or rejection of the quote. In one exemplary embodiment of the present invention, user 109 receives one or more quotes from a web site of any of RFQ providers 105. As such, user 109 may access the web site of any of RFQ providers 105 to receive and respond to one or more quotes" (emphasis added) (O'Malley; paragraph [0029]) as teaching both a "budgetary" or non-binding quote and a "contractual" quote, in view of the fact that non-acceptance of the quote means it is not-binding or "budgetary" while acceptance indicates it is "contractual."

In response to Applicant's argument at pages 2-3 of the 17 May 2006 response that the O'Malley reference fails to "describe or suggest a network based method for facilitating providing a customer with a quote for at least one of a manufactured product and a service" and at the paragraph bridging on pages 3-4 that "the user receives only a single quote" Examiner respectfully disagrees. As discussed above, in the O'Malley reference and additionally in O'Malley's Figure 3, Item 315, the user can receive one or more quotes. Further, O'Malley

teaches “[i]f user 109 ignores the quote or rejects the quote, then user 109 is not affected by the quote (e.g., user 109 is not legally or financially obligated in connection with the quote [reads on “budgetary quote”]). If, however, user 109 accepts the quote from any of RFQ providers 105 and/or the supplier, then user 109 may be obligated (e.g., legally, financially, or otherwise) [reads on “contractual quote”]” (emphasis added) (O’Malley; paragraph [0030]); Examiner interprets these teachings, together with the teachings cited above as teaching both a “budgetary” or non-binding quote and a “contractual” quote.

In response to Applicant’s argument at pages 4-5 of the 17 May 2006 response that the O’Malley reference fails to describe or suggest a computer readable medium encoded with a program configured to provide the customer a budgetary quote receive a customer response and provide the customer a contractual quote based on the customer response and that “the user receives only a single quote”, Examiner notes that O’Malley teaches a computer readable medium encoded with a program (O’Malley; paragraph [0012]) and also notes that the remainder of these arguments have been discussed earlier in this Office Action.

In response to Applicant’s argument in pages 5-6 of the 17 May 2006 response that there is no suggestion to combine the references, the Examiner notes that the motivations for combining the applied references can be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, the Examiner respectfully notes that each and every motivation to

combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. That is, in the instant application the motivations have been found in the references themselves. See for example the previous Office Action (paper number 04172006) “with the motivations of providing “a system and method for executing transactions...” (page 5, paragraph 6) and “with the motivations of providing “a web site that reduces ...”(page 8, paragraph 7) . As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93). It is respectfully submitted that contrary to Applicant's allegations, the features that Applicant disputes and the motivations for combining references are clearly within the teachings of the applied references and that Applicant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above. Consequently, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 04172006) have been expressly articulated.

In response to Applicant's arguments in paragraph 1 of page 6 to paragraph 3 of page 8 of the 17 May 2006 response that neither O'Malley nor Singh, considered alone or in

combination describes the limitations of claims 1, 3, 9, 11, 17 and 19, the arguments regarding these limitations have been discussed earlier in this Office Action.

In response to Applicant's arguments at the paragraph bridging pages 8-9 of the 17 May 2006 response that there is no suggestion to combine the references, these arguments have been discussed earlier in this Office Action.

In response to Applicant's arguments in paragraph 3 of page 9 of the 17 May 2006 response that neither O'Malley nor Duke, considered alone or in combination describes the limitations of claim 1, the arguments regarding these limitations have been discussed earlier in this Office Action.

In response to Applicant's arguments in paragraph 3 of page 9 of the 17 May 2006 response that neither O'Malley nor Duke, considered alone or in combination, describes sending an email alert to the customer that includes a URL indicating a location of the published budgetary quote, Examiner respectfully disagrees. Examiner interprets O'Malley's teachings of "communicate the quote to user" (O'Malley; paragraph [0028]) together with O'Malley's teachings of "[e]xemplary protocols include hyper text transfer protocol (http), secured hyper text transfer protocol (https), file transfer protocol, secure electronic mail, a network, ..." (emphasis added) (O'Malley; paragraph [0025]) combined with Duke's teachings of "advertisement" (reads on "email alert") comprises an "internet address" to an "internet quote site" (reads on "a Uniform Resource Locator (URL)") (Duke; page 8, lines 14-19, page 21, lines 15-19) to teach the argued limitations.

In response to Applicant's arguments in paragraph 2 of page 10 to paragraph 4 of page 11 of the 17 May 2006 response that neither O'Malley nor Duke, considered alone or in combination describes the limitations of claims 8, 9, 12-15, the arguments regarding these limitations have been discussed earlier in this Office Action.

In response to Applicant's arguments in paragraph 1 of page 12 to paragraph 2 of page 14 of the 17 May 2006 response that neither O'Malley nor Duke, considered alone or in combination describes the limitations of claims 17, 20-23, 24, the arguments regarding these limitations have been discussed earlier in this Office Action.

In response to Applicant's arguments at paragraphs 2-4 of page 15 of the 17 May 2006 response that there is no suggestion to combine the references, these arguments have been discussed earlier in this Office Action.

In response to Applicant's argument at the paragraph bridging pages 15-16 of the 17 May 2006 response that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

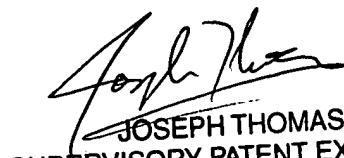
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

August 21, 2006



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER